

## REMARKS/ARGUMENTS

Initially, Applicant and his attorney would like to thank the Examiner, Mr. Frenel for reopening prosecution in response to the Appeal Brief filed on October 21, 2004.

Applicant elects herein to respond to the Office Action dated March 14, 2005 under 37 CFR 1.111.

Claims 1, 17 and 33 have been amended herein without prejudice. Accordingly, claims 1-48 are currently pending for examination in the present application. It is respectfully submitted that the claim amendments do not add new matter and have adequate support in the Specification.

Otherwise, Applicant respectfully traverses all claim rejections for the reasons that follow:

### **I. REJECTIONS OF CLAIMS 1-48 UNDER 35 U.S.C. § 103(a)**

Claims 1-48 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,014,629 to Bruin-Ashton (hereinafter "Bruin"), in view of U.S. Patent No. 6,283,761 to Joao (hereinafter "Joao"). Respectfully, Applicant traverses.

Claim 1, as amended herein, relates to "[a] system to match a consumer of health care services to a health care service provider over a communications network, the system comprising . . . a first software portion for automatically determining at least one treatment option based on a diagnosis . . . and a second software portion for **automatically determining at least one appropriate service provider based on the automatically determined at least one treatment option and further based on a treatment preference**, the treatment preference comprising at least one of: geographical location of the provider, insurance plan participation, cost, provider experience with the at least one treatment option and provider outcome with respect to the at least one treatment option.." (Amended Claim 1 (emphasis added)).

Bruin relates to "an improved directory of group physicians for health care service providers", (Bruin, col. 3, ll. 49-50), aimed at solving the expense, size and difficulties of using large printed publications of physician lists that are not updated frequently, and thereby contain erroneous and duplicate listing information. (See Bruin, col. 1, l. 40 to col. 2, l. 10). "The group

physician database is searchable at least by physician name, office address and/or specialty.” (Bruin, col. 6, ll. 65-67). The user designates “the localized geographic area corresponding to the customer” and searches “the group physician database . . . to identify those group physicians and other group care providers having offices within the specified local geographical area for the customer” and then selects “only those physicians having a particular specialty.” (Bruin, col. 7, l. 63 to col. 8, l. 5).

Joao, in one embodiment, discusses the determination of a treatment plan. This embodiment relates to an apparatus for a “user . . . [to] check on, verify, and/or ascertain the correctness of a diagnosis.” (Joao, col. 25, ll. 5-9), the apparatus having a “central processing computer [that] will “generate . . . a treatment report which will outline and/or prescribe treatment for the single diagnosis and/or for the list of possible diagnoses.” (Joao, col. 25, ll. 40-53). “The medical doctor can then . . . review [the] . . . treatment report and choose the a [sic] final . . . treatment plan, if needed, to administer to the patient.” (Joao, col. 25, ll. 54-62 (emphasis added)). Thereafter, “the medical doctor will transmit the final diagnosis and treatment plan . . . to the central processing computer.” Id. at ll. 63-66 (emphasis added).

Joao, in another embodiment, addresses the determination of a service provider. This embodiment of Joao relates to a system whereby “any patient, user, provider, payer and/or intermediary [can] locate a provider and/or a payer of healthcare and/or healthcare-related services, goods, or products.” (Joao, col. 30, ll. 50-53). This embodiment operates in accordance with the following example provided in Joao: “For example, assume that a patient has been recently diagnosed as needing an operation to repair his vision. The patient or his provider would need to find a doctor who specializes in performing the needed surgical procedure.” (Joao, col. 30, ll. 53-57). The system disclosed in Joao “can thereafter be utilized to locate a specialist for performing that function.” (Joao, col. 30, ll. 57-59). “[T]he patient or provider accesses the central processing computer and provides information regarding the service needed.” (Joao, col. 30, ll. 61-63). Accordingly, the patient or the provider inputs a desired treatment and the system of this embodiment described in Joao matches the user with a service provider based on the information provided by the patient or provider, and does not do so based on an automatically determined treatment option as in the present invention.

To establish a prima facie case of obviousness of a claimed invention, the Examiner must show that the combination teaches or suggests all of the claim limitations. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). In re Royka, 490 F.2d 981 (CCPA 1974); M.P.E.P. 2143.03. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970) (emphasis in original); M.P.E.P. 2143.03. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 171 (Fed Cir. 1988); M.P.E.P. 2143.03.

## **II. BRUIN IN VIEW OF JOAO DOES NOT DISCLOSE, TEACH OR SUGGEST EACH AND EVERY LIMITATION OF AMENDED CLAIM 1**

- A. *Bruin in view of Joao does not disclose, teach or suggest “a first software portion for automatically determining at least one treatment option based on a diagnosis.”*

In accordance with the above stated standard, it is respectfully submitted that the combination of Bruin and Joao does not disclose, teach or suggest, “a first software portion for **automatically** determining at least one treatment option based on a diagnosis” as recited in Claim 1.

With regard to Bruin, Applicant is in agreement with the Examiner’s concession that “Bruin-Ashton does not explicitly disclose” the above identified features of Claim 1. (Office Action, p. 3, para. 5). Bruin does not teach or suggest “a first software portion for automatically determining at least one treatment option based on a diagnosis,” as recited in Claim 1, because Bruin merely discloses a searchable directory of service providers within a consumer’s existing insurance coverage plan group. (Bruin, Abstract) Accordingly, Bruin does not teach or suggest the “determining at least one treatment option,” let alone doing so “automatically” as recited in Claim 1. Accordingly, Bruin does not disclose, teach or suggest “a first software portion for automatically determining at least one treatment option based on a diagnosis” as recited in Claim

1. Further, to the extent that Examiner asserts Joao “suggests” these features, (Office Action, p. 3, para. 6), Applicant respectfully traverses.

Like Bruin, Joao fails to disclose, teach or suggest a “software portion for automatically determining at least one treatment option,” as recited in Claim 1. In one embodiment Joao discloses a system for ascertaining “the correctness of a diagnosis”, as stated above, whereby **a medical doctor chooses the final treatment plan to administer to the patient.** (Joao, col. 25, ll. 54-62). Thereafter, it is also “**the medical doctor [who] will transmit the final diagnosis and treatment plan . . . to the central processing computer.**” Id. at ll. 63-66. The system as disclosed in Joao is thus unlike the system disclosed in the present invention because it does not automatically determine at least one treatment option, but rather **the determination is made by a medical doctor external to the disclosed system**, which is then provided back to the system by the doctor only after he/she has made the determination. In fact, Joao teaches away from the present invention by taking the final treatment determination out of the computer’s hands, so to speak, and placing that decision process with a medical doctor, thereby making the automatic determination of the treatment by the system as disclosed in Joao, an impossibility. As such, Joao does not disclose, suggest or teach “a software portion for automatically determining at least one treatment option,” as recited in Claim 1.

B. *Bruin in view of Joao does not disclose, teach or suggest “a second software portion for automatically determining at least one appropriate service provider based on the automatically determined at least one treatment option and further based on a treatment preference . . . .”*

In accordance with the above stated standard, it is respectfully submitted that the combination of Bruin and Joao does not disclose teach or suggest, “a second software portion for **automatically determining at least one appropriate service provider based on the automatically determined at least one treatment option** and further based on a treatment preference” as recited in Amended Claim 1.

Bruin does not teach or suggest “a second software portion for automatically determining at least one appropriate service provider based on the automatically determined at least one treatment option and further based on a treatment preference,” as recited in amended

Claim 1, because Bruin merely discloses a searchable directory of service providers within a consumer's existing insurance coverage plan group. (Bruin, Abstract). As discussed above in section II(A), Bruin does not disclose, teach or suggest "automatically determining at least one treatment option" and therefore could not, and does not, disclose, teach or suggest "automatically determining at least one appropriate service provider" as recited in amended Claim 1, because it is necessarily "based on the automatically determined at least one treatment option" that Bruin does not teach or suggest. Furthermore, Bruin applies to those searching within a group's coverage plan for a service provider whereby the searching is done by the consumer and is not done "automatically" by the system as required by amended Claim 1. Accordingly, Bruin does not disclose, teach or suggest these features recited in amended Claim 1. Further, to the extent that Examiner asserts Joao "suggests" these features, (Office Action, p. 3, para. 6), Applicant respectfully traverses.

Like Bruin, Joao fails to disclose, teach or suggest "a second software portion for **automatically determining at least one appropriate service provider based on the automatically determined at least one treatment option** and further based on a treatment preference," as recited in amended Claim 1. First, as discussed above in section II(A), Joao does not disclose, teach or suggest "automatically determining at least one treatment option" and therefore could not, and does not, disclose, teach or suggest "automatically determining at least one appropriate service provider" as recited in amended Claim 1, because it is necessarily "based on the automatically determined at least one treatment option," a feature that Joao does not teach or suggest. Accordingly, since Joao does not disclose, teach, or suggest "the automatically determined at least one treatment option", teaching "**automatically determining at least one appropriate service provider based on the automatically determined at least one treatment option**" as recited in amended Claim 1 would be an impossibility.

Furthermore, to the extent that Joao addresses the determination of a provider, that determination is made based on information that "**the patient or provider . . . provides . . . regarding the service needed.**" In other words, unlike the present invention in which the provider is automatically determined by the system based on the automatically determined treatment option determined by the system, in Joao the patient or the provider inputs a desired

treatment and it is only then, after the user inputs their information, that the system described in Joao matches the user with a doctor specialized to provide the desired treatment. This embodiment of Joao does not teach the use of an automatically determined treatment option, because, in fact, the treatment option is specified by the consumer as opposed to being automatically determined by the computer. Accordingly, Joao does not disclose, teach or suggest “a second software portion for **automatically determining at least one appropriate service provider based on the automatically determined at least one treatment option** and further based on a treatment preference,” as recited in amended Claim 1.

Even further, assuming arguendo that Joao does teach “automatically determining at least one treatment option” in its embodiment requiring a “user . . . [to] check on, verify, and/or ascertain the correctness of a diagnosis,” Joao does not suggest or teach using an automatically determined treatment option to select a service provider. There is no suggestion within Joao to combine the teachings of the two embodiments presented herein even if it did teach “automatically determining at least one treatment option,” which it does not.

For at least the foregoing reasons argued above in sections II(A) and II(B), it is respectfully submitted that the elements of amended Claim 1 are not disclosed, taught or suggested by the combination of Bruin and Joao. Accordingly, it is respectfully submitted that amended Claim 1 is allowable over Bruin in view of Joao. Furthermore, since Claims 2 -16 ultimately depend from amended Claim 1, it is respectfully submitted that Claims 2 -16 are also in allowable form.

Claim 17, as amended herein, incorporates the features of amended Claim 1 as it recites “a method to match a consumer of health care services to a health care service provider over a communications network, the method comprising . . . [inter alia,] automatically determining with the computer program at least one treatment option based on a diagnosis . . . and **automatically determining with the computer program at least one appropriate service provider based on the automatically determined at least one treatment option** and further based on a treatment preference . . .” (Amended Claim 17).

As such, for at least the same reasons presented above, it is respectfully submitted that the combination of Bruin and Joao does not disclose, teach or suggest each and every

element of amended Claim 17. Accordingly, it is respectfully submitted that Claim 17 is allowable over Bruin in view of Joao. Furthermore, since Claims 18-32 ultimately depend from amended Claim 17, it is also respectfully submitted that Claims 18-32 are in allowable form.

Claim 33, as amended herein, incorporates the features of amended Claim 1 as it recites “[a] computer readable storage medium for a program for operating a system to match a consumer of health care services to a health care service provider over a communication network . . . comprising a computer program comprising: a first software portion for automatically determining at least one treatment option based on a diagnosis . . . and **a second software portion for automatically determining at least one appropriate service provider based on the automatically determined at least one treatment option** and further based on a treatment preference . . . .” As such, for the same reasons as above, it is respectfully submitted that the combination of Bruin and Joao do not disclose, teach or suggest each and every element of amended Claim 33. Accordingly, it is respectfully submitted that Claim 33 is allowable over Bruin in view of Joao. Furthermore, since Claims 34-48 ultimately depend from Claim 33, it is respectfully submitted that Claims 34-48 are in allowable form.

Accordingly, it is kindly requested that the rejections of claims 1-48 under 35 U.S.C. § 103(a) be withdrawn.

### III. CONCLUSION

In view of the foregoing, it is respectfully submitted that all pending claims are currently in allowable condition. Accordingly, reconsideration and prompt allowance of all pending claims is therefore earnestly solicited.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 14, 2005.

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